

## **REMARKS**

Prior to this response, claims 13, 33, 35, 36, 38-50, 59-66, and 76-84 were pending in the application. No claims have been have amended, added or cancelled. Accordingly, claims 13, 33, 35, 36, 38-50, 59-66, and 76-84, of which claims 13, 76, and 83 are independent, are still pending in the application.

### **General Comments**

The present Action is indicated to be a Final Action; however, Applicant believes that such a designation is improper and asks that the Remarks below be consider and addressed and the claims either allowed, or a response provided. First, the claim rejections under section 112 are no more than a verbatim rehash of the rejection included in the prior office action, to which Applicant provide a response. The Action makes no attempt to respond to Applicant's arguments in this regard. As noted below, Applicant respectfully requests that this rejection be withdrawn, or Applicant's arguments overcome. Moreover, the failure to address Applicant's response should preclude the issuance of a Final Action as not all of Applicants arguments were considered. Second, the rejections under section 103 again fail to make out a *prima facie* case of obviousness. More importantly here, the arguments put forth in the Action continue the pattern of shifting interpretations and weak explanations for why the inventions claimed would be obvious to one of skill in the art; arguments Applicant has consistently overcome.

Applicant feels it is unfair, and inappropriate that he be forced into the added time and expense of either an RCE or Appeal, at least until a consistent interpretation of the claims and the prior art being relied on has been presented. Applicant is happy to address any relevant prior art and any arguments of obviousness, but it is unfair to make this a moving target by "hiding the

ball” behind shifting and inconsistent interpretations of the prior art and the claims. Not to mention the fact that each Action to date has failed to indicate how the prior art teaches each and every element of the claims as required. A fact that cannot be a mistake at this point, since Applicant has pointed out this failure in response to each Action.

To restate: Given the deficiencies of the past and present actions, Applicant believes that the “Final” status of the present action is improper and respectfully request consideration of the remarks herein and/or allowance of the claims

### **Claim Rejections Under §112**

Paragraph 4 of the Action rejects claim 84 under 35 U.S.C. §112, first paragraph, for falling to comply with the enablement requirement. Specifically, the Action states that the limitation “. . . wherein the at least one advertisement associated with the source is less than 1 second long,” is not described in the specification. Applicant addressed this rejection in the last response. The present Action claims to have considered Applicant’s response in this regard, but simply reiterates that the specification does not explicitly include a statement that an advertisement can be less than 1 second long, i.e., the Action fails to actually address Applicant’s remarks and simply restates the rationale for the rejection of the last office action.

Applicant has addressed the concern raised in this and the prior Actions and it is simply unquestionable that the specification provides the proper support under section 112. There really can be no question that the specification provides one of skill in the pertinent art to make and use the invention as claimed in claim 84, which is all that is required. Stated another way, section 112 does not require that each limitation be supported in each instance by an explicit and verbatim statement in the specification.

Applicant will not take the time to restate his previous comments in response to this rejection, but suffice it to say that Applicant stands by them at least until provided with an adequate response thereto. Accordingly, Applicant respectfully request withdrawal of the rejection.

**Claim Rejections Under §103:**

Paragraph 5 of the Action rejects claims 13, 33, 35, 36, 38-48, 59-64 and 84 under 35 U.S.C. §103(a) again as being unpatentable over Gregorek (U.S. Patent 5,557,658) in view of Hidary (U.S. Patent 5,852,775) in further view of Inoue (JP 57087661). Unlike the prior action, which rejected these claims based on the exact same combination, the present Application relies on the other of the two embodiments disclosed in Inoue, an embodiment Applicant referred to in overcoming the last rejection. Applicant again traverses the rejection because Gregorek, Hidary, and Inoue, alone or in combination, fail to make out a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” See MPEP §706.02(j).

In this case, the Action fails to make out *prima facie* case of obviousness because Gregorek, Hidary, and Inoue, alone or in combination, do not teach each and every limitation of the claims. Claim 13 includes the limitation of replacing the ring tones in a ring back signal with

short advertisements. This limitation has been present in the claims from early on and has been rejected under various combinations, including Gregory and Hidary, in previous Actions. In each instance, Applicant has overcome the rejections by pointing out that the prior art does not in fact teach replacing the ring tones in a ring back signal with short advertisements, and this rejection is no different.

For example, a previous Action stated that the claims do not sufficiently recite replacing the rings of a ring back signals with a series of short advertisements as opposed to replacing the entire ring back signal. Applicant respectfully disagreed because the claims (including claim 13 in its present form) recite “. . . cause . . . [a] short advertisement associated with the source to replace the rings of a ring back signal.” Accordingly, Applicant asserted, and still asserts that the claims cite sufficient detail.

A previous Action further stated that the ring back signal is also short and that an advertisement that replaced the ring back signal would therefore be short. Applicant noted that this statement apparently admits Gregorek teaches replacing the ring back signal and not the individual ring tones. Applicant further noted that while a ring back signal may be short, it is clearly not as short as the ring tones. Thus, a continuous message of 5-30 seconds as taught in Gregorek clearly would not be sufficient to achieve the invention as claimed in claims 76 and 83, and now 13.

Previous Actions attempted to address Applicant’s previous arguments that the prior does not teach replacing the ring tones of the ring back signal with short advertisement, by stating that “[t]his is irrelevant to the claimed invention.” Applicant of course respectfully disagreed, because as Applicant noted the limitations at issue are expressly contained in three separate

claims (34 (now 13) 76, and 83), two of which (claims 76 and 83) are independent claims. Thus, Applicant noted that the limitations were quite relevant.

Applicant has also noted in the past that it is an unquestioned tenant of patent law that in order for a reference to render a claim unpatentable, it must teach each and every element of the invention as claimed. Moreover, “the identical invention must be shown in as complete detail as contained in the . . . claim.” (*See* MPEP §2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Applicant noted that the art cited in previous Actions, including Gregorek, did not teach the above limitation and that more recent Actions made no assertion to the contrary, but rather tried to overcome the deficiencies in the cited references by stating, e.g., that it is not relevant to the claimed inventions, which is clearly not the case.

After several Actions that while rejecting claims 34 (now 13), 76, and 83, put forth no new grounds for rejecting claims 34 (now 13), 76, and 83, the previous Action stated that Inoue teaches this limitation; however, Inoue too does not teach this limitation. As Applicant previously pointed out, Inoue appears to teach two embodiments: One in which a Talkie signal (TKE) is superimposed over the entire ring back signal (Fig. 3(b)), and a second in which the period between the ring tones (RBT) is replaced with a TKE signal (Fig. 39a)). Applicant also pointed out, that with respect to the second embodiment, which was being relied on in that Action, Inoue is merely cumulative with respect to the Sleevi patent already disclosed in the background of the present application. Thus, Inoue does not teach that the actual ring tones (RBT) can be replaced. .

As discussed in the interview of December 3, 2007, the difference between Applicant’s claims and the previously relied on embodiment of Inoue can be found on page 4 of the

translation in the third full paragraph where it states: "In Figure 3(a), talkie signal TKE is transmitted when the callout signal RBT is not transmitted (emphasis added)." Whereas, in claim 13, the advertisements are transmitted when RBT signal is transmitted, or more specifically during the period the RBT signal would be transmitted, since the advertisements replace the ring tone or RBT portion of a ringback signal.

In response the present Action now relies on the other embodiment of Inoue in which a Talkie signal (TKE) is superimposed over the entire ring back signal (Fig. 3(b)). First, this is merely cumulative of the teachings of Gregorek, which have been addressed and overcome numerous times in this file history (See, e.g., the above discussion). Second, Gregorek was overcome, because replacing the entire ring back signal is not the same as replacing the rings of the ring back signal with short advertisement. Thus, the newly relied on embodiment of Inoue fails to teach each and every limitation of the claims at issue, and in what is becoming a pattern in this increasingly lengthy file history, the present Action in fact presents no new grounds for rejection.

Applicant also points out the alleged motivation to combine the teachings to the prior art provided in the present action is in fact little more than a self serving statement that is not necessarily supported by the references themselves. While the test for obviousness may have been loosened under the recent *KSR* decision, the protections against hindsight are still in place. Accordingly, to make out a proper *prima facie* case, the references themselves must still teach each and every limitation, which is not the case here, and something of the combination being asserted must be evidenced from the references themselves. Thus, self serving statements based on hindsight, such as those included in the present Action are still frowned on, even under a more liberal application of the test for obviousness.

Based on the above, Applicant respectfully asserts the claim 13 is allowable over the art of record. Claims 33, 35, 36, 38-48, 59-64 and 84 ultimately depend from claim 13 and are therefore allowable for at least the reasons discussed with respect to claim 13. Applicant, therefore respectfully requests withdrawal of the rejection of claims 13, 33, 35, 36, 38-48, 59-64 and 84.

Paragraph 6 of the Action rejects claims 49-50 and 65-66 under 35 U.S.C. §103(a) as being unpatentable over Gregorek in view of Hidary, in further view of Inoue, in further view of Creamer (U.S. Patent 6,028,917). Claims 49-50 and 65-66 ultimately depend from claim 13 and are therefore, allowable for at least these same reason unless Creamer can make up for the deficiencies of Gregorek and Hidary, which it cannot. Applicant therefore respectfully request withdrawal of the rejection as to claims 49-50 and 65-66.

Paragraph 7 of the Action rejects claim 76 under 35 U.S.C. §103(a) as being unpatentable over Chavez Jr. (U.S. Patent 6,603,844), in view of Inoue. Applicant respectfully traverses the rejection because neither Chavez, Jr., nor Inoue, alone or in combination, teach every limitation of claim 76.

Similar to claim 13, claim 76 includes replacing the ring tones of a ring back signal with a short advertisement. The Action admits that Chavez Jr. does not teach this limitation, and as explained above, neither does Inuoe. Accordingly, the Action fails to make out a *prima facie* case of obviousness with respect to claim 76 and Applicant respectfully requests that the rejection be withdrawn.

Paragraph 8 of the Action rejects claims 77 and 83 under 35 U.S.C. §103(a) as being unpatentable over Chavez Jr. in view of Inoue, in further view of Gregorek. Claim 77 depends from claim 76 and is therefore allowable for the same reasons as discussed with respect to claim

76 and 13. Similar to claim 13, claim 83 includes replacing the ring tones of a ring back signal with a short advertisement. Accordingly, claim 83 is allowable for the reasons discussed above. Applicant therefore, respectfully requests withdrawal of the rejection as to claims 77 and 83.

Paragraph 10 of the Action rejects claim 78-82 under 35 U.S.C. §103(a) as being unpatentable over Chavez Jr., in further view of Inoue, in further view of Hidary. Claims 78-82 ultimately depend from claim 76 and are therefore allowable for at least the reasons discussed with respect to claim 76 and 13. Applicant therefore respectfully requests withdrawal of the rejection of claims 78-82.



**CONCLUSION**

Applicant believes that given the above amendments and remarks, the claims are now in condition for allowance and such is respectfully requested. No new claim fees are believed to be necessitated by this response. The Examiner is requested to charge any additional fees that may due with this response to deposit account 13-0480.

Respectfully submitted,

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